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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/771,263	02/04/2004	Takayuki Shimada	BJS-829-620	1391

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NIXON & VANDERHYE, PC  
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ARLINGTON, VA 22203

EXAMINER
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CHIEN, LUCY P

ART UNIT	PAPER NUMBER
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2871

MAIL DATE	DELIVERY MODE
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07/25/2011

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/771,263	<b>Applicant(s)</b> SHIMADA ET AL.	
	<b>Examiner</b> LUCY CHIEN	<b>Art Unit</b> 2871	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 4/22/2011.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-24 and 34-60 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☒ Claim(s) 1-24 and 34-60 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 04 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                       | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>4/22/2011</u> .   | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Response to Arguments***

Applicant's arguments with respect to claim 1-24,34-60 have been considered and the rejection has been withdrawn and claims are objected. Please file the appropriate documents as noted below.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to

be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

**Claim 1,3,14,16** are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1,16 of U.S. Patent No. 6097452. Although the conflicting claims are not identical, they are not patentably distinct from each other because

Claims 1,14 are obvious over Claim 16 of U.S. Patent No. 6097452

Claims 3,16 are obvious over Claim 1 of U.S. Patent No. 6097452

## **1. Reissue Declaration**

The reissue declaration filed on June 14, 2005 has been accepted.

**Applicants have added claims 34-60 to provoke an interference (see Applicant's Statement under 37 CFR 41.202(a) filed on 7/6/07). Please note that a reissue cannot be based solely on to suggest copying claims for the purpose of establishing interference. See MPEP 1449.02.**

## **2. Supplement Reissue Declaration is required because:**

(1) If additional defects or error are corrected in the reissue after the filing of the application and the original reissue oath or declaration, a supplemental reissue oath/declaration must be filed, unless all additional error corrected are spelling, grammar, typographical, editorial or clerical errors which are not errors under 35 U.S.C. 251 (see MPEP 1402). In other words, a supplemental oath/declaration is required

where any "error" under 35 U.S.C. 251 has been corrected and the error was not identified in the original reissue oath/declaration.

Supplemental Reissue Declaration is required for the additional corrections/amendments which were filed on 7/6/07. Claims 34 and 43 were amended and claims 50-60 were newly added.

If a new declaration is submitted to state an error that supports this reissue then a supplemental declaration is not needed. See MPEP 1414.01 and FP 14.05.02

**3. The Amendments to the Claims are improper because Amendments do not comply with 37 CFR 1.173(c):**

The Amendment to the Claims filed on 7/6/07 is improper since the subject matter deleted from an original patent claim must be placed between brackets and the subject matter added by reissue to the original patent claim must be underlined. See 37 CFR 1.173(b)(2) and (d). See MPEP 1453.

Claim 34 is new claims added by reissue, thus all limitations in claim 34 should be underlined without bracket or strike through.

***Allowable Subject Matter***

**Claims 1-24,34-60** are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

**Regarding Claim 1,14,34,43,52,**

Noda et al (Fig. 2G - Fig. 30G) discloses a liquid crystal display device, gate lines (1330), source lines (S), switching elements (1700) each arranged near a crossing of each gate line and each source line, a gate electrode (1777) of each switching element being connected to the gate line (1330), a source electrode (S) of the switching element being connected to the source line (2204), a drain electrode (D) of the switching element being connected to a pixel electrode (1787) for applying voltage to a liquid crystal layer, wherein an photosensitive acrylic resin (column 5, rows 50-55 and column

9, rows 60-67) insulating layer is etched (1784). The insulating layer covers the drain electrode (D) to insulate from other electrodes, the gate line, and the source line. The pixel electrode (1787) is on the interlayer insulating film (1784), the pixel electrode (3017) overlaps the source line (S). The insulating film (1784) is 1.5  $\mu\text{m}$  or more (Fig. 17)

Noda et al does not disclose a photosensitive resin having a dielectric constant of 3.4 to 3.8, and a spectral transmittance of the transparent interlayer organic insulating film has a lower transmittance for blue light than that for green and red light.

Sunohara et al discloses the property of the polyimide has a dielectric constant of 3.5  $\mu\text{m}$ . (Column 10, rows 34-43). But, Sunohara et al does not disclose the desired photosensitive polyimide layer by Noda et al, thus it does not make sense to combine the two references.

The prior art does not disclose nor would it have been obvious to one of ordinary skill in the art to disclose a photosensitive resin having a specific dielectric constant of about 3.4-3.5 which is the dielectric constant of the layer needed to provide a organic insulating film having lower transmittance for blue light than that for green and red light.

Claims 2-13 depend on Claim 1, therefore are allowable.

Claims 15-24 depend on Claim 14, therefore are allowable.

Claims 35-42 depend on Claim 34, therefore are allowable.

Claims 44-51 depend on Claim 43, therefore are allowable.

Claims 53-60 depend on Claim 52, therefore are allowable.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to LUCY CHIEN whose telephone number is (571)272-8579. The examiner can normally be reached on M-F 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Nelms can be reached on (571)272-1787. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Lucy P Chien/

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Primary Examiner, Art Unit 2871